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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/792,123	03/03/2004	Heinz Gunther Eisen	IR3712 NP	3923

31684 7590 08/23/2005

ARKEMA INC.
PATENT DEPARTMENT - 26TH FLOOR
2000 MARKET STREET
PHILADELPHIA, PA 19103-3222

EXAMINER	
EDWARDS, LAURA ESTELLE	
ART UNIT	**PAPER NUMBER**
1734	

DATE MAILED: 08/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/792,123	EISEN ET AL.	
	Examiner	Art Unit	
	Laura Edwards	1734	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *06 June 2005*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-7* is/are pending in the application.

4a) Of the above claim(s) *3* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1, 2, and 4-7* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on 6/6/05 is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

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Election/Restrictions

This application contains claim 3 is drawn to a non-elected invention. A complete reply to the final rejection must include cancellation of nonelected claim or other appropriate action.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1, 2, and 4-7 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The specification as originally filed fails to explicitly teach or suggest injection means as now recited in claims 1 and 4. While the specification does set forth feeding lances for feeding the coating liquid into the internal area of the sponge as set forth on page 2.

Claims 1 and 2 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, line 7, "the internal area" lacks antecedent basis. It is suggested that "the internal area" be changed to --an internal area--.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1, 2, and 4-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Peek (US 4,962,721) in view of Weihrauch (US 6,685,376).

Peek teaches a sponge applicator system for coating select portions of an outer surface of a container with a coating liquid comprising an open cell foam (col. 5, lines 42-45) having surface sections (36, 38), at least one surface section (38) designed to contact a portion of the container, said foam having an internal porosity allowing for flow of coating liquid through the open cell structure of the sponge, and means for supplying the coating liquid via gravity or pressure (i.e., so as to inject the coating liquid into the foam). Peek is silent concerning providing at least one surface section open to flow of coating liquid while all other surface sections are sealed to prevent the flow of coating liquid on the surface of the container. However, it was known in the foam applicator art, at the time the invention was made, to provide

a foam applicator with at least one surface section or zone open to flow of coating liquid for application to a select portion of a work surface with all other surface sections sealed to prevent flow of coating liquid in order to minimize waste of coating liquid as evidenced by Weihrauch (see col. 2, lines 37-47 and col. 7, lines 30-38). Weihrauch further recognizes that coating or application liquid can be supplied to the interior of the foam applicator with its sealed and unsealed surface sections (see col. 7, lines 54-60). It would have been obvious to one of ordinary skill in the art to provide a foam applicator having at least one surface open to flow of coating liquid for selective application of the coating liquid on the surface of the container and have the remaining surface sections of the applicator closed, as taught by Weihrauch, in the Peek sponge applicator system so as to enable application of coating liquid to a select portion(s) of the container and not other portions so as to minimize waste of coating liquid and thereby lower manufacturing costs.

With respect to claim 2, Peek and Weihrauch are silent concerning a sponge applicator having the arrangement of two unsealed surface sections for contacting a first portion of the container and another two unsealed surfaces for contacting a second portion of the container. However, it would have been obvious to one of ordinary skill in the art to provide an appropriate arrangement of sealed and unsealed surface sections of the foam applicator in accordance with desired application of coating liquid to the container being coated. It is within the purview of one skilled in the art to arrange the applicator with sealed and unsealed surface sections for applying coating liquid only to select areas or portions of the container as would be expected when using a variety of different shaped and sized containers.

With respect to claim 4, Peek provides a sponge coating applicator system comprising a foam sponge having at least one unsealed surface open to flow of liquid, means for contacting the container with the unsealed open surface, and means for supplying the coating liquid to the foam sponge and means for supplying the coating liquid via gravity or pressure (i.e., so as to inject the coating liquid into the foam). Peek is silent concerning providing at least one surface section open to flow of coating liquid while all other surface sections are sealed to prevent the flow of coating liquid on the surface of the container. However, it was known in the foam applicator art, at the time the invention was made, to provide a foam applicator with at least one surface section or zone open to flow of coating liquid for application to a select portion of a work surface with all other surface sections sealed to prevent flow of coating liquid in order to minimize waste of coating liquid as evidenced by Weihrauch (see col. 2, lines 37-47 and col. 7, lines 30-38). Weihrauch further recognizes that coating or application liquid can be supplied to the interior of the foam applicator with its sealed and unsealed surface sections (see col. 7, lines 54-60). It would have been obvious to one of ordinary skill in the art to provide a foam applicator having at least one surface open to flow of coating liquid for selective application of the coating liquid on the surface of the container and have the remaining surface sections of the applicator closed, as taught by Weihrauch, in the Peek sponge applicator system so as to enable application of coating liquid to a select portion(s) of the container and not other portions so as to minimize waste of coating liquid and thereby lower manufacturing costs.

With respect to claim 5, see the response above to claim 2.

With respect to the container being a glass or plastic bottle, this limitation has been given no patentable weight because it is the type of container intended to be used with the applicator.

However, Peek recognizes the use of the applicator for standard food and beverage containers (see col. 5, lines 30-35) such that the glass or plastic bottle would be encompassed therein.

Response to Arguments

Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Laura Edwards whose telephone number is (571) 272-1227. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris Fiorilla can be reached on (571) 272-1187. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Laura Edwards
Primary Examiner
Art Unit 1734

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August 20, 2005